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Remarks

Claims 1 to 12, 22, 23 and 25 to 29 are in this application.

Claims 1 to 3, 11 and 12 have been allowed.

Claims 25 to 29 have been added to further define the scope of the invention.

Reconsideration of the new grounds of rejection of claims 4 to 10, 22 and 23 as being anticipated by the newly cited Popat (US 5,389,414) is requested.

Claims 4 to 10, 22 and 23 have been rejected as being anticipated by Popat. The Examiner alleges that Popat meets the structure of applicant's claimed structure and that the blank of Popat is considered to be capable of "making at least one laminated novelty product", "receiving imaging. . . folding. . . and back-to-back relation" and "folding over" a fourth section. . . issue is taken in this respect.

As set forth at MPEP 2173.01 (Claim Terminology), a fundamental principle contained in 35 USC 112, second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as any special meaning assigned to a term is clearly set forth in the specification. Applicants may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the court in *In re Swinehart*, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.

The Courts have held that a functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some

part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, (supra).

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step. *Innova/Pure Water Inc. v. Safari Water Filtration Sys. Inc.*, 381 F.3d 1111, 1117-20, 72 USPQ2d 1001, 1006-08 (Fed. Cir. 2004),

A rejection under 35 USC 102(b) requires that "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The Examiner apparently agrees that the identical invention as claimed is not shown in Popat in view of his reliance only his consideration that the blank of Popat is *capable* of the recited requirements of the claims.

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). To establish inherency, the

extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

#### Claim 4

In the present case, the Examiner has not established that the blank of Popat is capable of the requirements of claim 4.

Claim 4 requires, in part, "a second of said areas on an opposite side of said line from said first area having a removable second section therein spaced from said first section for folding over and onto said first area and for receiving imaging thereon related to the imaging on said first section" and "a layer of adhesive on each of said sections for laminating said sections to each other".

Popat describes a divisible laser label sheet 20 that, as indicated in Fig. 4, includes a label sheet 46, a pressure sensitive adhesive coating 49 on the label sheet 46 and a backing sheet 48 which has a silicone release coating. The label sheet 20 is divided into four subsections by perpendicular lines of microperforations 30 and 32 that pass through the label sheet 46 and the backing sheet 48. (See col. 4, lines 5 to 9).

In use, the label sheet 20 of Popat is divided along the perforations 30,32 into four sub-sections, each of which includes a set of labels 34. . Each subsection is then sent through a laser printer. (See col. 4, lines 25 to 34).

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There is no teaching in Popat that the pressure sensitive adhesive coating 49 is to do anything other than to allow the label layer 46 to be mounted on the backing layer 48.

Further, there is no teaching in Popat that the label sheet 20 is to be folded about the lines of microperforations 30 and 32. Instead, Popat teaches that the four subsections of the label sheet 20 are to be separated and that the labels are to be individually removed from the respective subsection of the label sheet 20.

Popat teaches that a standard sized sheet of cardstock can be perforated to form several subsections each having a set of separable business cards rather than labels. In this embodiment, there is no teaching that the individual business cards that are removed from the sheet are to be laminated to each other or to any other substrate. In fact, it would appear that the teaching of Popat is that the business cards may be handled as discrete elements. From this teaching, it would appear that the adhesive described in Popat is not capable of laminating two business cards in back-to-back relation.

In view of the above, a rejection of claim 4 as being anticipated by Popat is not warranted pursuant to the provisions of 35 USC 102(b).

Claim 5 depends from claim 4 and is believed to be allowable for similar reasons.

Claim 6

Claim 6 contains recitations similar to claim 4 and is believed to be allowable for similar reasons.

Claim 7

Claim 7 depends from claim 6 and further requires that "each of said removable sections of said second and fourth areas have sub-sections adhered to said liner for removal therewith to provide windows in said removable sections of said second and fourth areas for exposure of adhesive therethrough". Popat is void of any such teaching or of any structure that is "capable" of having a section of the label sheet 46 removed with the backing layer 48. For this reason alone, a rejection of claim 7 as being anticipated by Popat is not warranted pursuant to the provisions of 35 USC 102(b).

Claim 8

Claim 8 contains recitations similar to claim 4 and is believed to be allowable for similar reasons.

Claim 9 and 10 depend from claim 8 and each is believed to be allowable for similar reasons.

Claim 22

Claim 22 contains recitations similar to claim 4 and is believed to be allowable for similar reasons.

Claims 23 and 25 depend from claim 22 and are believed to be allowable for similar reasons.

Claim 26

New Claim 26 contains recitations similar to claim 4 and is believed to be allowable for similar reasons.

Further, claim 26 is directed to a blank comprising "a sheet of paper having a fold line. . . ". Popat has no teaching of a fold line. instead, Popat requires the label sheet

20 to be divisible. Use of a fold line for the microperforations 30,32 in Popat would be contrary to the teachings of Popat. For this reason alone, a rejection of claim 26 as being anticipated by Popat is not warranted pursuant to the provisions of 35 USC 102(b) or as being unpatentable over Popat is not warranted pursuant to the provisions of 35 USC 103.

Still further, claim 26 requires "an adhesive only on one of said sections for laminating said sections to each other upon folding of said first section and said second section about said fold line and onto each other and without laminating the remainder of said first area to said second area ...". Popat does not describe or teach such a structure. Instead, Popat provides a pressure sensitive adhesive coating 49 on the entire label sheet 46 which allows the label sheet to mount onto the backing layer 48 (col.3, lines 39 to 41). In the claimed structure, the adhesive is only on one of the removable sections and not on the remainder of the sheet as in Popat. For this additional reason, a rejection of claim 26 as being anticipated by Popat is not warranted pursuant to the provisions of 35 USC 102(b) or as being unpatentable over Popat is not warranted pursuant to the provisions of 35 USC 103.

Claims 27 and 28 depend from claim 26 and each is believed to be allowable for similar reasons. Further, claim 28 requires the removable liner to be "of smaller height and width than said sheet of paper". Popat does not describe or teach such a structure. Instead, the label sheet 46 and backing layer 48 of Popat are the same size.

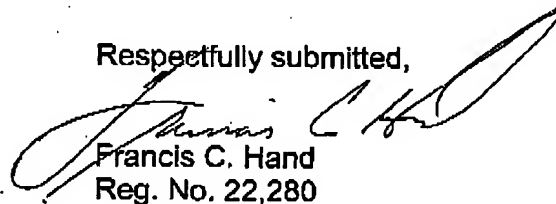
Claim 29

Claim 29 requires "a sheet of paper having a fold line to separate two areas within said sheet". As noted above with respect to claim 26, Popat does not describe or teach such a structure.

Further, claim 29 requires "an adhesive only on each of said sections for laminating said sections to each other upon folding of said first section and said second section about said fold line and onto each other and without laminating the remainder of said first area to said second area". Popat does not describe or teach such a structure. Accordingly, a rejection of claim 29 as being anticipated by Popat is not warranted pursuant to the provisions of 35 USC 102(b) or as being unpatentable over Popat is not warranted pursuant to the provisions of 35 USC 103.

The application is believed to be in condition for allowance and such is respectfully requested.

Respectfully submitted,



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